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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,460	03/25/2004	Toshiki Taguchi	Q80704	4866

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT	PAPER NUMBER
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1755

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,460

Applicant(s)

TAGUCHI ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. ____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/25/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The references cited in the Search Report dated May 18, 2004 have been considered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 7, the term "using" is indefinite. A "process" defined in the sole terms of "using" does not define patentable subject matter under 35 USC 101. See *In re Fong*, 129 U.S.P.Q. 264 (CCPA 1961). The examiner suggests incorporating ink jet method steps into this claim to overcome the rejection. °

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double

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patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 14 of copending Application No. 10/611,990 (US 2004/0055508). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are generic to said copending claims and would be obvious thereby.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

In the above copending Application No. 10/611,990, it is the examiner's position that it would have been obvious to one having ordinary skill in the art that the relation of $\epsilon_1/\epsilon_2 > 1.2$ wherein ϵ_1 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.1 mmol/liter using a cell having a light pass length of 1 cm and ϵ_2 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.2 mmol/liter using a cell having a light pass length of 5 μm since the dyes of copending Application No. 10/611,990 are the same structure as those claimed (and disclosed) by applicants.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-7 are rejected under 35 U.S.C. 102(a) as being anticipated by EP 1384762.

EP 1384762 teaches an ink set for ink jet recording comprising a yellow ink, a magenta ink, a cyan ink, a black ink and a dark yellow ink wherein each of the ink comprises a dye, a water-miscible organic solvent and water. The dark yellow ink comprises a heterocyclic azo magenta dye of the general formula (I-a) and a phthalocyanine cyan dye of the general formula (I-b). EP 1384762 further teaches an ink jet recording method comprising ejecting the above ink set onto a recording medium. See page 2, line 45 – page 3, line 52, page 4, lines 4-10 and lines 17-44, page 8, line 39 – page 9, line 20, the dyes on pages 10-22, page 27, lines 1-53, the dyes on pages 30-49, page 60, lines 40-43, examples 1, 4, 8 and 11, Table 15 and claims 1-3, 5 and 6. The ink set as taught by EP 1384762 appears to anticipate the present claims.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

8. Claims 1-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Miyamoto et al. (US 2004/0055508).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Miyamoto et al. teach an ink for ink jet recording comprising at least one dye of the formula (1) dissolved or dispersed in an aqueous medium and a betaine surfactant. Miyamoto et al. also teach that the above ink may be used together with other color inks as an ink set. Miyamoto et al. further teach an ink jet recording method comprising ejecting the above ink set onto a recording medium. See paras. 0009-0013, para. 0031, para. 0042, paras. 0098-0103, the dyes on pages 9-27, para. 0116, example 1, Table 14, para. 0302 and claims 1-4 and 14. The ink and ink set as taught by Miyamoto et al. appears to anticipate the present claims.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

The only limitation in the claims not found by the examiner is the relation of $\epsilon_1/\epsilon_2 > 1.2$ wherein ϵ_1 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.1 mmol/liter using a cell having a light pass length of 1 cm and ϵ_2 represents a molar extinction coefficient obtained from absorbance at the maximum wavelength of a spectral absorption curve obtained by measuring an aqueous solution of the dye having a concentration of 0.2 mmol/liter using a cell having a light pass length of 5 μm . However, this limitation is considered inherent because there does not appear to be any reason why the above cited references would not contain a dye with applicants claimed relation since the dyes of the above references are the same structure as those claimed (and disclosed) by applicants.

Conclusion

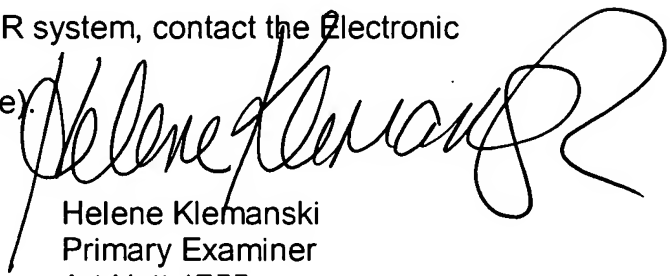
The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Helene Klemanski
Primary Examiner
Art Unit 1755



HK

January 23, 2006